IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	10/667,419	Confirmation No. 1092
Applicant	:	Yuval Berenstain	
Filed	:	23 Sept 2003	
TC/A.U.	:	1762	
Examiner	:	William P. Fletcher III	
Docket No.	:	2960/1	

Commissioner of Patents and Trademarks
Washington, D.C. 20231
ATTENTION: Board of Patent Appeals and Interferences

APPELLANT'S REPLY BRIEF

Sir:

This is in response to the Examiner's Answer mailed 23 August 2007. This Reply Brief being filed on or before 23 October.

ARGUMENTS - REBUTTAL OF THE EXAMINER'S ANSWER

In the Examiner's Response to Arguments as presented in the Examiner's Answer, the Examiner states,

> "...The Examiner's position holds that: (a) because Dong teaches the production of decorative laminates, this would have suggested application of the dyes and pigments in any suitable and aesthetically desirable fashion and that doing so would have been obvious to one of ordinary skill in the art; and (b) there is no evidence of record that the binder applicator taught by Dong requires 100% coverage..."

Regarding (a), the Examiner states,

> "...The finished product of Dong is a decorative laminate. The mere fact that the finished product is decorative in nature makes the kind and degree of decoration subjective to the desire of the artisan. There is nothing in Dong limiting the kind and degree of decoration in any way. The only decoration explicitly disclosed by the reference, such as a wood-grain appearance [3:28-29], are exemplary and non-limiting [see also 1:7-13 and 3:20-29]. References are part of the literature of the art, relevant for all they contain, may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments; non-preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments [MPEP 2123]. Consequently, in the production of a decorative laminate in which the artisan intends for the decorative layer to transmit only partially through the overlay, application of a suitable amount and distribution of dye/pigment to the overlay (i.e., in an amount less than 100%) would have been well within the scope of what is suggested by Dong's broad disclosure. Similarly, in the production of a laminate in which the artisan desires for transmittance of a certain color and/or pattern of the underlayer through the decorative layer, application of a suitable amount and distribution of dye/pigment to the underlayer (i.e., an amount of less than 100%) would have been well-within the scope of what is suggested by Dong's broad disclosure. Finally, the issue of obviousness is not determined by what the references expressly state but what they would reasonably suggest to one of ordinary

skill in the art [In re *Siebentritt,* 152 USPQ 618 (CCPA 1967)]. [emphasis added by Examiner]

Firstly, Appellant points out that it is Dong's preferred embodiment that teaches an overlay, decorative layer, underlay and substrate layers and that within this preferred embodiment is only with regard to the decorative layer of that Dong teaches exemplary and non-limiting decorations. As mentioned in earlier papers, Appellant asserts that there is no teaching of the application of the dyes and pigments in any decorative or aesthetically desirable fashion to non-woven fabric.

Secondly, Appellant points out that Dong discusses the results of 27 tests. The various decorative layers include two printed papers, two printed PVC films, a clear PVC film and three wood veneers. Therefore, Appellant challenges the Examiner's statement that, "...The only decoration explicitly disclosed by the reference, such as a wood-grain appearance [3:28-29], are exemplary and non-limiting..." Clearly Dong explicitly discloses no less than eight different decorative layers in three very different media. While these tests are indeed exemplary and non-limiting with regard to the decorative layer, Appellant points out that in none of the 27 tests discussed is there mention of a decorative laminate in which the artisan intends for the decorative layer to transmit only partially through the overlay, or the production of a laminate in which the artisan desires for transmittance of a certain color and/or pattern of the underlayer through the decorative layer, as suggested by the Examiner. Nor is there hint or suggestion that such laminate would be beneficial or desirable. To the contrary, discussion of the overlay is directed to clarity of the layer so as not to interfere with the visual clarity of the decorative layer through the overlay. Further, there is no mention of decorative manipulation of the underlay what so ever in the Dong disclosure.

Therefore, Appellant challenges the Examiner's statement above, "...non-preferred embodiments do not constitute a teaching away from a broader disclosure..." Appellant asserts that it is not the non-preferred but rather the preferred embodiments that teach away from the present invention and that the broader disclosure does not teach toward, hint at or suggest the manipulation of the non-woven material in the manner suggested by the Examiner.

Appellant reiterates that the production of a decorative laminate in which the artisan intends for the decorative layer to transmit only partially through the overlay, and therefore applies a suitable amount and distribution of dye/pigment to the overlay; or the production of a laminate in which the artisan desires transmittance of a certain color and/or pattern of the underlay through the decorative layer, and therefore applies a suitable amount and distribution of dye/pigment to the underlay is neither hinted at nor suggested anywhere in Dong. As well, one of ordinary skill in the art would not have turned to Dong for a solution to the problem of applying a finishing agent to less than 100% of the surface of a non-woven fabric as part of the production line process.

With regard to (b), the Examiner states,

> "...With respect to (b), as noted above, there is no evidence of record that the binder applicator of Dong, the device by which coating material is applied to the underlay, overlay, and/or substrate, is necessarily a disclosure of 100% coverage of the underlay, overlay, and/or substrate. Further, even if application by binder applicator results in 100% coverage, Appellant's claimed range of "less than 100%" is inclusive of coverage amounts infinitesimally smaller than 100%. In Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) it was held that a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. It is the Examiner's position that one of ordinary skill in the art would have expected a finishing agent coverage of 100% (outside of the claimed range) to have the same properties as a finishing agent coverage of 99.999...% (the claimed range) and that there is no

> evidence or suggestion of the criticality of the latter coverage over the form of record in this application..." [emphasis added by Examiner]

Appellant challenges the Examiner's statement that, "...It is the Examiner's position that one of ordinary skill in the art would have expected a finishing agent coverage of 100% (outside of the claimed range) to have the same properties as a finishing agent coverage of 99.999...% (the claimed range) and that there is no evidence or suggestion of the criticality of the latter coverage over the form of record in this application..." Appellant wishes to clarify that it is not the properties of the finishing agent whether applied at 100% coverage or 99.999% coverage of the surface of the non-woven fabric. Rather, it is the method by which the finishing agent is applied to the surface of the non-woven fabric that is the claimed invention of the instant application.

To that end, Appellant asserts that the method of Dong teaches the addition of finishing agents to the white-water slurry, which inherently provides 100% coverage, and a binder applicator. Since a binder applicator is intended for the application of a binder for the purpose of binding together non-woven fibers so as to ensure 100% binding of the fibers and it would be undesirable for some of the fibers not to be bound together when producing the non-woven fabric, Appellant asserts that one of ordinary skill in the art would have expected a binder applicator to provide 100% coverage to any surface to which it was used to apply a substance. While the Examiner may be correct in that the binder applicator may serendipitously not provide 100% coverage, Appellant contends that regarding the teachings of Dong, such lack of coverage would be considered by one of ordinary skill in the art to be a fault to be avoided rather than a creative manipulation to be emulated.

Appellant asserts that a method in which 100% coverage is intended and less than 100% coverage may erroneously occur is differentiated from a method in which less than

100% coverage of the surface is intended and 100% coverage does not occur, as in the method of the present invention as claimed in claims 1 and 19 of the instant application.

The Appellant, therefore, respectfully requests that these rejections be overturned by the Board of Patent Appeals and Interferences.

Respectfully submitted,

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